

### **REMARKS**

The Office Action of June 18, 2003, has been reviewed and the comments therein were carefully considered. Claims 1-32 remain pending. Claims 4 and 6 have been amended to correct typographical errors.

### **Claim Objections**

Claims 4 and 6 were objected to as containing informalities. The claims have been amended in the manner suggested by the Examiner.

### **Rejections under 35 USC § 112, First Paragraph**

Claims 1-32 stand rejected under 35 U.S.C. 112, first paragraph. The Office Action alleges that the claims contain subject matter which was not described in the specification. In particular, the Office Action asserts that the “[s]pecification does not use, much less define, the term ‘readability formatting values’, nor is that term known in the art so as to enable one skilled in the art to make and use ‘readability formatting values’”.

The Applicant respectfully disagrees with this assertion. The independent claims were amended to include the limitation of “optimized readability formatting values.” The Applicant believes that it is clear from the specification and drawings that the formatting values described throughout the specification are formatting values that affect readability and that they are optimized with respect to readability. For example, the following section from the background of the invention describes formatting variables that affect readability:

“Additionally, **the capability to quickly alter formatting variables in electronic documents has not necessarily improved the readability** of electronic documents,

and in many cases seriously detracts from readability. An example of this would be when a user resizes a typical Web browser so that it occupies the entire display of a desktop or laptop computer. In many Web document implementations, this immediately results in a line length for the main text of the document which is uncomfortable to read because it requires excessive head and eye movement to take in the full lines of text. That is, a problem with many platforms currently used to display electronic documents is that they allow certain formatting variables to be changed without necessarily optimizing the other formatting variables as a result. For example, in some word processing applications, one can increase or decrease the size of the font used. In response, the word processing software will increase the amount of leading. While this may be appropriate in some cases, it still ignores the typographic principle that other formatting variables should also be altered in light of the change to the font size in order to optimize readability of the document. Similar deficiencies exist in other platforms. For example, in the "ROCKET EBOOK" device, the capability exists to adjust font size between a large and small setting. However, changing this variable does not appear to result in the other formatting variables being changed to optimally cooperate with the new font size. The effect of this failure to optimize formatting variables is the likely degradation of the overall readability of the electronic document." (Page 2, line 17 - Page 3, line 12)

The Summary of the Invention includes the following section that indicates that the formatting variables described are those that affect readability:

"The present invention provides a technique for modifying formatting variables in an electronic document based in part upon optimized formatting values. To this end, a user may specify values for one or more user-modifiable formatting variables of a plurality of formatting variables. Based on the user data thus specified, at least a portion of the plurality of formatting variables are modified according to corresponding optimized formatting values. The electronic document is then formatted in accordance with the modified formatting variables and provided for display. In a preferred embodiment, the user-modifiable variables comprise a font reference variable (e.g., selecting a small font or a large font) and/or or a display form factor variable. In this manner, the present invention allows for user preferences in displaying electronic documents, and yet optimizes readability of such documents despite changes to formatting variables resulting from user preferences." (Page 3, line 22 – Page 4, line 3)

The Detailed Description of the Invention also clearly indicates that the optimized formatting values are optimized with respect to readability. For example, see the following section:

“The present invention provides a technique for modifying formatting variables in an electronic document based in part upon optimized formatting values. In this manner, maximum readability of electronic documents is ensured regardless of user display preferences.” (Page 13, line 10-12)

The Abstract of the Invention includes the following section that also makes it clear that the formatting variables are those that affect readability:

“The electronic document is then formatted in accordance with the modified formatting variables and provided for display. The user-modifiable variables may comprise a font reference variable and/or a display form factor variable. In this manner, the present invention optimizes readability of electronic documents while still accommodating user preferences for displaying such documents.” (Abstract lines 6-10)

On page 2, the Office Action indicates that the values shown in tables 2 and 3 are “exemplary values for formatting values.” On page 9, lines 5-6, the specification indicates that the values shown in tables 2 and 3 are “optimized” formatting values. The Applicant respectfully submits that one skilled in the art would clearly understand after reading the specification that the values are optimized with respect to readability. As a result, the formatting values shown are optimized readability formatting values.

For at least the forgoing reasons, the Applicant respectfully submits that it is clear from the specification that the claimed “optimized readability formatting values” are values of formatting variables that have been optimized with respect to readability. Moreover, tables 2 and 3 provide specific examples that would allow one to make and use a system that includes “optimized readability formatting values.” The Applicant accordingly requests reconsideration of this rejection.

#### **Rejections under 35 USC § 112, Second Paragraph**

Claims 1-32 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action alleges that the scope of the "readability formatting values" is unclear.

As described above, several claims include the limitation of "optimized readability formatting values" and the scope of this limitation covers values of formatting variables that have been optimized with respect to readability. The Applicant requests reconsideration of this rejection.

**Rejections under 35 USC § 102 and § 103**

The present Office Action includes the same prior art rejections included in the Office Action of 2/24/03. The prior art rejections do not address or respond to the amendments made in the Amendment filed 5/22/03. In particular, the prior art rejections do not even allege that the cited references teach or suggest the claimed limitations of "optimized readability formatting values."

The Applicant respectfully submits that claims 1-32 are patentable over the references cited in the present Office Action for at least the reasons provided in the Amendment filed 5/22/03.

**CONCLUSION**

In view of the above discussion, the Applicant respectfully submits that claims 1-32 are in condition for allowance. Reconsideration and allowance of claims 1-32 is respectfully requested. Should the Examiner believe that a conversation with the Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call the Applicant's representative.

Respectfully submitted,

Dated: October 17, 2003

*William J. Allen 51,393 for Charles*  
Charles L. Miller *Miller*

Appl. No.: 09/456,150  
Amendment Dated: October 17, 2003  
Reply to Office Action of June 18, 2003

Registration No. 43,805  
BANNER & WITCOFF, LTD.  
Ten South Wacker Drive  
Suite 3000  
Chicago, Illinois 60606  
Telephone: (312) 463-5000  
Facsimile: (312) 463-5001